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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/649,516	08/29/2000	AKIHIRO YAMADA	107170	9098

25944 7590 03/24/2004

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P.O. BOX 19928  
ALEXANDRIA, VA 22320

EXAMINER

LUU, LE HIEN

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/649,516

Applicant(s)

YAMADA ET AL.

Examiner

Le H Luu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 and 14-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. Claims 1-27 are presented for examination.
2. Applicant's election with traverse of claims 8-13 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that all claims 1-27 is sufficiently related that a thorough search for the subject matter of any one Group of claims would encompass a search for the subject matter of the remaining claims. This is not found persuasive because there are four different inventions in this patent application. The inventions are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other as discussed in paper no. 7. The inventions are distinct, each from the other because of the following reasons: These inventions have acquired a separate status in the art as shown by their different classification, and the search required for one Group is not required for the other Groups. For the reasons above restriction for examination purposes as indicated is proper. The requirement is still deemed proper and is therefore made FINAL.
3. Applicant is required to cancel the non-elected claims 1-7 and 14-27 in responding to this office action.
4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

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to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8-13 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Mori** patent no. **6,089,765**, in view of **Whitehouse et al. (Whitehouse)** patent no. **6,687,684**.

6. As to claim 8, Mori teaches the invention substantially as claimed, including a printing system for performing printing operations on a plurality of print data sets, the printing system comprising:

a reprint setter that sets, for each print data set, a reprint representing reprinting operations are to be performed on each print data set, and that appends, as appended information, a corresponding reprint command to each of the plurality of print data sets (col. 5 lines 39-64; col. 6 lines 33-44);

a holder that holds the plurality of print data sets as targets of reprint processes (col. 4 lines 26-29);

a reprint controller that retrieves, from the holder, a print data set for which a reprint command is received and that controls reprint processes for the retrieved print data set (col. 5 lines 39 - col. 6 line 3); and

a print data eraser that erases, from the holder, each print data set that the reprint controller has used for reprint processes for a number of times (col. 4 lines 56-65; col. 7 lines 52-61).

However, Mori does not explicitly teach setting a reprint number representing an upper limit.

Whitehouse teaches setting a limit on the number of reprint requests (col. 2 lines 26-40; col. 5 lines 30-49).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Mori and Whitehouse to set a reprint number representing an upper limit because it would ensure efficient fraud protection.

7. As to claim 9, Whitehouse teaches the reprint number setter reduces the reprint number for a print data set each time the reprint controller uses the print data set for a reprint operation (col. 6 lines 42-53).

8. As to claim 10, Mori teaches the print data eraser erases a print data set from the holder when the reprint number setter changes the reprint number for the print data set to zero (col. 4 lines 56-65; col. 7 lines 52-61).

9. As to claim 11, Mori teaches a reprint number change preventor that prevents the reprint number setter from changing the reprint number set for each print data set (col. 6 lines 25-32).

10. As to claim 12, Mori teaches a client device for preparing the print data sets; and a print controller for controlling printing processes performed for the print data sets, wherein the client device includes: the reprint number setter; and a transmitter that transmits, to the print controller, print data and appended information including the reprint number; and the print controller includes: a receiver that receives, from the client device, print data and the appended information including the reprint number; the holder; the reprint controller; and the print data eraser (Mori, col. 3 line 44 - col. 4 line 55; col. 7 lines 52-61; Whitehouse, col. 2 lines 26-40; col. 5 lines 30-49).

11. Claim 13 has similar limitations as claim 1; therefore, they are rejected under the same rationale.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Le H. Luu, whose telephone number is (703) 305-9650. The examiner can normally be reached Monday through Friday from 7:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia, can be reached at (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

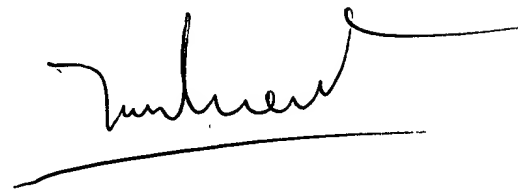
or faxed to:

(703) 872-9306, (for formal communications; please mark  
"EXPEDITED PROCEDURE").

Or:

(703) 872-9306 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal  
Drive, Arlington. VA., Sixth Floor (Receptionist).

A handwritten signature in black ink, appearing to read 'Le Hien Lou', with a long horizontal line extending to the right.

LE HIEN LOU  
PRIMARY EXAMINER

March 15, 2004